

REMARKS

By the above amendment, claims 11 and 18 have been amended at this time.

The rejection of claims 1-18 under 35 U.S.C. 103(a) as being unpatentable over Oyama et al (US 5,942,319) is traversed, and reconsideration and withdrawal of the rejection are respectfully requested.

As to the requirements to support a rejection under 35 U.S.C. 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual

question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

In setting forth the rejection, the Examiner states that:

Oyama discloses (fig 17a) a display apparatus with a film on a display plane, the film having (fig 4) a luminous transmittance equal to or less than 85%, (fig 10, table 1) a luminous reflectance equal to or less than 1% and a flattened reflectance curve, of which absolute values of differential values are equal to or less than 2 with the film provided on an outer surface of the display plane. (emphasis added)

Applicants note that claim 1, recites the feature of "a flattened reflectance curve, of which absolute values of differential values in a visible light region of 380 nm - 780 nm are equal to or less than 2" (emphasis added) and by the present amendment, independent claim 11 has been amended to incorporate the features of dependent claim 18 which are the same features as recited in claim 1. Applicants note that in the amendment filed December 28, 2001, arguments and evidence has been presented showing that Oyama does not disclose the aforementioned features in the sense of 35 U.S.C. 102 or in the sense of 35 U.S.C. 103, and applicants submit that the Examiner has no basis for contending that such features as recited in claims 1 and 11 are present in Oyama.

Rather, the Examiner apparently contends that the features recited in claims 1, 2, 4, 8, 9, 11, 15 and 18 are functional recitations which have "not been given patentable weight because it is narrative in form." (emphasis added) Applicants submit that this position by the Examiner is improper. More particularly, the Examiner contends:

In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 U.S.C. §112, sixth paragraph, and must be supported by recitation in the claims of sufficient structure to warrant the presence of the functional language. (emphasis added)

Hereagain, applicants submit that the Examiner is in error and "means" language is not required for patentable consideration. Applicants submit that the recitation as set forth in the claims of this application recite the properties of the film as disclosed, and such properties cannot be ignored. Reference is made to the decision of In re Swinehart and Sfiligoj, 169 USPQ 226 (CCPA 1971), wherein the court pointed out that we take the characterization "functional" as used by the Patent Office and argued by the parties, to indicate nothing more than the fact that an attempt is being made to define something (in this case, a composition) by what does rather than by what it is as evidence by specific structure or material, for example. In our view, there is nothing intrinsically wrong with use of such a technique in drafting patent claims. Indeed, we have even recognized in the past the practical necessity for the use of functional language. The court pointed out that we are convinced that there is no support, either in the actual holdings of prior cases or in the statute, for the proposition, put forward here, that "functional" language, in and of itself, renders a claim improper. We have also found no prior decision of this or any other court which would may be said to hold that there is some other ground for objecting to a claim on the basis of any language, "functional" or otherwise, beyond what is already sanctioned by the provisions of 35 U.S.C. §112.

Applicants submit that as pointed out in the arguments presented in the prior amendment and the evidence submitted therewith, Oyama does not disclose a film having the properties as set forth in independent claim 1 and independent claim 11 of "a flattened reflectance curve of which absolute values of differential values in a visible light region of 380 nm - 780 nm are equal to or less than 2", with evidence being presented that Oyama provides values outside of the values recited in claims 1

and 10. Thus, applicants submit that claims 1 and 10 as well as the other claims of this application recite features regarding properties of the film, which features are not disclosed by Oyama in the sense of 35 U.S.C. 103, and all claims should be considered allowable thereover.

With regard to claims 5-7, the Examiner contends "it would have been obvious to one having ordinary skill in the art at the time the invention was made to select an appropriate material for the film, since it would be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use." (emphasis added) Applicants submit that this position by the Examiner has been rejected by the court. See In re Fine, supra and In re Lee, supra.

With regard to independent claims 3, 7 and 10, such claims recite a laminated film composed of at least three layers comprising a protective film, a conductive film and an absorption film at a surface of a display plane, with claim 3 reciting the feature that the laminated film is constituted so that the absorption film contains coloring matter and is arranged at a position closer to said display plane than said conductive film. Independent claim 10 recites similar features to that of claim 3, whereas independent claim 7 further recites features of the laminated film as being constituted so that a first layer in the order from an outer surface of said laminated film is said protective layer composed mainly of SiO_2 , a second layer is said conductive layer composed of at least one metal selected from the group consisting of Ag, Pd, Pt, Cu, Cr and Au, and a third layer is said absorption film containing color matter.

Although the Examiner now contends that the aforementioned features are disclosed or taught by Oyama, applicants note that the Examiner in the Office Action dated June 28, 2001, in the last paragraph at page 3, stated that "Oyama fails to specifically point out having a selective absorption to approximately 450 nm, 570 nm, and 650 nm and the absorption film containing coloring matter." (emphasis added)

Applicants submit that Oyama does not disclose an absorption film containing coloring matter or the other features as recited in claims 3, 7 and 10, in the sense of 35 U.S.C. 103.

More particularly, while the Examiner refers to a protective film (13) and an absorption film (11) at a surface of a display plane (10), it is readily apparent that such refers to Fig. 1 of Oyama which only discloses a two layer film. On the other hand, Fig. 2 of Oyama discloses a three layer film formed of the layers 21, 22 and 23 provided on a display plane 20. Irrespective of the contentions by the Examiner, film 21, which is provided on the display plane 20, as described in col. 16, line 56 to col. 17, line 4, is a "titanium nitride film" which is a conductive film, film 22, which is provided on film 21, is a "titanium oxide film" which is a non-conductive film and film 23, which is provided on film 22, is a "silica film" which may be considered to be a protective film. Applicants submit that the disclosure of Oyama is that the film closest to the display plane 20 is a conductive film 21 of "titanium nitride" which is contrary to the recited features of claims 3, 7 and 10. Additionally, as pointed out above, there is no disclosure or teaching in Oyama of the absorption film containing coloring matter, and arranged closer to the display plane than the conductive film. As such, applicants submit that each of the independent claims of this application patentably distinguish over Oyama in the sense of 35 U.S.C. 103, and should be considered allowable thereover.

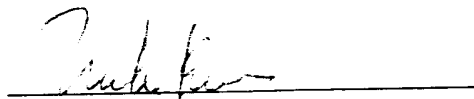
As to the features of the dependent claims, applicants submit that such features are not disclosed by Oyama when considered in conjunction with the parent claims, and these dependent claims further patentably distinguish over the cited art, such that all claims present in this application should now be in condition for allowance.

In view of the above amendments and remarks, applicants submit that all claims present in this application patentably distinguish over Oyama in the sense of

35 U.S.C. 103 and should be considered allowable thereover. Accordingly, issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (503.37677X00) and please credit any excess fees to such deposit account.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Melvin Kraus", is written over a horizontal line.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amend claims 11 and 18 as follows:

11. (amended) A Braun tube comprising a film on a display plane, wherein said film has:

a luminous transmittance equal to or less than 85%,

a luminous reflectance equal to or less than 2 %, and

a flattened reflectance curve, of which absolute values of differential values in a visible light region of 380 nm - 780 nm are equal to or less than 2.

18. (amended) A Braun tube as claimed in claim 11, wherein said film is provided on an outer surface of said display plane, ~~and the absolute values of differential values of said flattened reflectance curve in a visible light region of 380 nm - 780 nm are equal to or less than 2.~~